

REMARKS

In the Office Action mailed December 23, 2005, a restriction was made between the following allegedly patentable distinct inventions:

Group I, claims 1-19 and 20-51, drawn to a negative electrode comprising a substrate a lithium secondary battery comprising a separator; and

Group II, claims 52-62, drawn to a negative electrode comprising a polymer film deposited with metal.

In the same Office Action, an election of species requirement was made between the following allegedly patentable distinct species:

- A, pick:
- 1) have a conductive material (claim 6), or
 - 2) not have a conductive material.

- B, pick:
- 1) metal foil (choose one from claim 8), or
 - 2) metal film (choose one from claim 8), or
 - 3) conductive polymer film (choose one from claim 9), or
 - 4) a polymer film deposited with metal (choose one from claim 10 or claim 57 or 61), or
 - 5) a polymer film incorporated with a conductive agent (choose one polymer film from claim 11 or claim 50, and one conductive agent from claims 12-13).

- C, pick:
- 1) lithium included metal oxide (choose one from claim 21), or
 - 2) a lithium-included chalcogenide compound (choose one from claim 21), or
 - 3) a sulfur-based material (choose one from claim 22), or
 - 4) a conductive polymer.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

In order to comply with the requirements of 37 CFR §1.142 and §1.146 and MPEP §809.02(a), Applicants provisionally elect, with traverse, to prosecute claims **1-7, 10, 14-30, 33, 37-41, 45 and 47** from Group I, in response to the preliminary restriction requirement set forth in the Office Action.

Applicants further provisionally elect the conductive material of claim 6, Species A: the polymer film deposited with a metal of claim 7 and the polyester of claim 10, Species B; and the lithium-included metal oxide (formula 5) of claim 21, Species C.

Moreover, the Examiner asserts on page 5 of the Office Action that no claims are considered generic. However, it is respectfully submitted that claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 and claims 52-58 and 61 are generic in that claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 are drawn to a negative electrode for a lithium secondary battery having a polymer film deposited with metal and claims 52-58 and 61 are also drawn to a negative electrode for a lithium secondary battery having a polymer film deposited with metal. As such, it is respectfully requested that at least claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 and claims 52-58 and 61 are generic. As such, it is respectfully requested that should claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 be allowed, claims 52-58 and 61 should be rejoined.

II. Applicants Traverse the Requirement

Insofar as Groups I and II are concerned, it is believed that claims 52-62 are so closely related to elected claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 that they should remain in the same application. The elected claims 1-7, 10, 14-30, 33, 37-41, 45 and 47 are directed to a negative electrode for a lithium secondary battery and claims 52-62 are also drawn to a negative electrode for a lithium secondary battery. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both sets of claims in the same field of technology. While it is noted that the Examiner has identified different classifications for both sets of claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the

additional subject matter recited by Group II claims by filing divisional applications.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

III. Conclusion

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

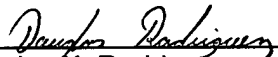
If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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